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V.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/390,583	09/02/99	ANDERSEN	P 11527.209

IM22/0204

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EXAMINER

COPENHEAVER, B

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/390,583

Applicant
Andersen et al.

Examiner
Blaine R. Copenheaver

Group Art Unit
1771



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 32-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 32-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The submission establishing ownership interest was signed by applicant's attorney. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324 and 37 CFR 3.73(b).
2. The present application fails to comply with MPEP 1411.01, because the application does not contain the changes corrected in the Certificate of Correction.
3. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.
4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: (1) the oath/declaration is not executed by the inventors (See 37 CFR 1.63); and (2) all of the claims, namely claims 32-51, are drawn to subject matter which was canceled in response to a restriction requirement during the prosecution of the original patent (See MPEP 1450 and *In re Orita*, 193 USPQ 145). Reissue may not be utilized to reclaim subject matter which was nonelected in the original application. 35 USC 251 cannot be used to circumvent other statutory requirements, e.g. the copendency requirement of 35 USC 120 for filing divisional applications on nonelected subject matter. It is noted that in the original application, namely U.S. Serial No. 08/327,524, the examiner required a three group restriction in Paper #5. In that restriction requirement, Group I, the starch-based composition, was elected and ultimately issued into U.S. Patent No. 5,662,731. And, Group II was drawn to the formed

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foamed article, which was not elected and canceled prior to the allowance of U.S. Patent No. 5,662,731.

5. Claims 32-51 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 32-34, 38, 40-43 and 45-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Haas et al. (US 5,576,049). Haas discloses an article of manufacture comprising: a starch-bound cellular matrix comprising a starch-binder and fibers dispersed throughout the matrix; and a biodegradable coating on at least a portion of the matrix. The matrix is capable of degrading after prolonged exposure to water. Haas discloses several of the coating materials of claims 33, 49 and 51, such as cellulose acetate and protein. The matrix can be a closed cell foam material (column 3, lines 33-39). Haas discloses a fiber concentration and matrix thickness within

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the presently claimed ranges. Haas also discloses that inorganic fillers, such as colorants may be included in the mixture that forms the matrix. Haas anticipated the claimed subject matter.

8. Claims 32-34, 38, 40-43 and 45-51 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 94/13734. WO '734 discloses an article of manufacture comprising: a starch-bound cellular matrix comprising a starch-binder and fibers dispersed throughout the matrix; and a biodegradable coating on at least a portion of the matrix. The matrix is capable of degrading after prolonged exposure to water. WO '734 discloses several of the coating materials of claims 33, 49 and 51, such as cellulose acetate and protein. The matrix can be a closed cell foam material. WO '734 discloses a fiber concentration and matrix thickness within the presently claimed ranges. WO '734 also discloses that inorganic fillers, such as colorants may be included in the mixture that forms the matrix. WO '734 anticipated the claimed subject matter.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 35-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Haas et al. (US 5,576,049) or WO 94/13734 each in view of WO 91/12186. Neither Haas nor WO '734 disclose applying the coating as a laminate material or using fibers having a length greater than 1.5 mm. WO '186 discloses that it is conventional in the art to laminate coating materials onto starch-bound cellular matrices. WO '186 discloses that such lamination results in

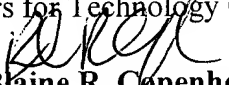
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desired bendability and foldability of the resulting laminate. It would have been obvious to the skilled artisan to have laminated the coating materials of Haas and WO '734 onto the matrix, as taught in WO '186, motivated by the desire to obtain a biodegradable composite laminate which exhibited desired bendability and foldability properties. With regard to the fiber length limitation of claim 39, it would have been obvious to the skilled artisan to have used fibers having a length greater than 1.5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In the present case, it would have been obvious to the skilled artisan to use fibers having a length of greater than 1.5 mm, motivated by the desire to obtain a matrix having enhanced tensile and flexural strengths.

11. Claim 44 is not rejected by any prior art, because none of the prior art documents cited in the issued patent or herein disclose or fairly suggest a starch-bound cellular matrix comprising fibers and at least 20 wt.% inorganic filler.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine R. Copenheaver whose telephone number is (703) 308-1261. The examiner can normally be reached on Tuesday-Friday from 6:30 AM-4:00 PM and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Terrel H. Morris, can be reached at (703) 308-2414. The fax numbers for Technology Center 1700 are (703) 305-7718 and (703) 305-3601.


Blaine R. Copenheaver
Primary Examiner
Art Unit 1771

B. Copenheaver
February 1, 2000